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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,950	12/11/2001	John K. Thottathil	LD74A DIV I	3992

23914 7590 09/24/2003

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EXAMINER

TRINH, BA K

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,950

Applicant(s)

THOTTATHIL ET AL.

Examiner

Ba K. Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/11/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,13-21,26 is/are pending in the application.
- 4a) Of the above claim(s) 13, 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1-8, 13-21, 26 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 14-21, are drawn to a process of making taxane, classified in class 549, subclass 510.
- II. Claims 13, 26, are drawn to an acid ester, classified in class 560, subclass 19.

The above delineated group are distinct because of their recognized divergent subject matter based on their different classifications and their chemical structures. A search of one group is not required for the search of other group and vice versa. A reference of one group would not suggest and/or render the other group obvious in the absence of the secondary teachings. Thus, the restriction requirement as indicated is deemed proper.

During a telephone conversation with Mr. Kenneth Peist on September 5, 2003 a provisional election was made with traverse to prosecute the invention of I, claims 1-8, 14-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13 and 26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mas et al.

Mas et al teaches a process of making taxanes wherein oxazolidine reacts with baccatin III to form the taxanes. The prior art oxazolidine (compound VII in the abstract) contains R<sub>3</sub> and R<sub>4</sub> groups being alkyl and R<sub>5</sub> group being alkoxy which are analogous to the current R<sub>5</sub> and R<sub>6</sub> and R<sub>1</sub> respectively based on the analogy of the alkyl group. Thus, it would be prima facie obvious to modify the process of Mas et al by using the analogous oxazolidine of Mas et al to react with baccatin III to form taxane derivatives without the unobvious and/or unexpected results.

Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Commercon et al.

Commercon et al teaches a process of making taxanes wherein oxazolidine reacts with baccatin III to form the taxanes. The prior art oxazolidine (compound VII in the abstract) contains R<sub>3</sub> group being alkoxy and R<sub>1</sub> group being benzoyl or alkoxy carbonyl (R<sub>2</sub> being alkyl) which are analogous to the current OR<sup>8</sup> group and R<sub>1</sub> group respectively based on the analogy of the alkyl group and the aryl group embraces phenyl as a species (benzoyl moiety). Thus, it would be prima facie obvious to modify

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the process of Commercon et al by using an analogous oxazolidine of Commercon et al to reacts with baccatin III to form taxane derivatives in the absence of unobvious and/or unexpected results.

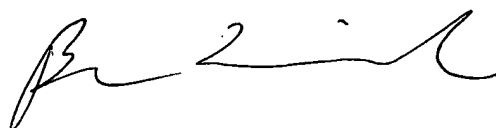
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Trinh whose telephone number is 308-4545. The examiner can normally be reached on Monday-Friday 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Trinh/tgd  
September 9, 2003



**BA K. TRINH**  
**PRIMARY EXAMINER**  
**GROUP 1200 1625**